



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,643	07/25/2000	Noriaki Hiraga	052593-5003	7356

9629 7590 05/07/2003

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

KITOV, ZEEV

ART UNIT

PAPER NUMBER

2836

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/625,643

Applicant(s)

HIRAGA, NORIAKI

Examiner

Zeev Kitov

Art Unit

2836

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 11, 15, 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 11, 15, 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

Examiner acknowledges a submission of the amendment and arguments filed on January 30, 2003. Claims 1, 2,5, 7,10 and 15 are amended. However, an amendment did not resolve problems associated with Claim Rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

1. Claims 1 – 11, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A reason for that is that the independent Claim 1 is formulated in such vague terms, that it is hard to reach an appropriate level of understanding necessary for examination. The claim states a number of elements. The first one is “plurality of active elements in a second connection-configuration including elements of an identical or similar structure to an active element in a first connection configuration connected to said inter-circuit wire”.

And further, “said plurality of active elements in said second connection configuration being connected to power lines of said internal circuits associated therewith and being isolated from signal wires other than said inter-circuit signal

Art Unit: 2836

wire". Attempt to associate the elements of the claim with elements of Fig. 1 has failed; examiner could not find such elements in the drawings. Attempt to associate the claim elements with the elements shown in Fig. 1 and 2 have failed. The question, what are the elements of the first or second connection configuration is hard to answer. According to a Specification (page 18, lines 14 – 18), the second connection configuration element is a protective element. According to Claim 1 language, this element is supposed to be connected simultaneously to both supply lines and to inter-circuit signal wire. However, the protective elements (elements 22, 24, 26 and 28 in Fig. 1) are being connected to the supply lines, but not connected to the inter-circuit signal wire, and other protective elements (elements 26 and 28 in Fig. 2) while being connected to the inter-circuit signal wire (element 12), but not connected to the signal wires (only to the ground). Therefore, none of the elements of Fig. 1 or Fig. 2 satisfies all the requirements of Claim 1.

Another issue is the inter-circuit signal wire, which according to the claim language, is not directly connected to an input or output circuit. Examples of Fig. 1 – 3 show the line 12, which is supposedly the inter-circuit signal wire, as being directly connected to circuit's 12AP/12AN and 12BP/12BN in Fig. 1 and 2. It is not clear at all, why these circuits are not the input and output circuits. From electrical engineering point of view, these are the input and output circuits, because they receive and transmit the input and output signals.

As to another independent Claim 5, is rephrases the same elements of Claim 1 and therefore presents the same difficulty of understanding.

While the language of the Specification is clear enough, the claim language is hard to understand and confusing.

In a first Office Action an examination of Claims 5 – 11, 15 and 16 was performed based on the examiner's best interpretation of the claims in light of the 35 USC 112, 2<sup>nd</sup> paragraph rejection. However, since the Amendment did not help in understanding of the claims, but even made it even ~~more~~ <sup>more</sup> difficult, a lack of understanding of the claims precludes the Examiner at this stage from continuing an examination. Therefore, no art examination has been conducted.

For proper examination the claims should be reformulated. No new matter should be added.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

Art Unit: 2836

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Response to Arguments***

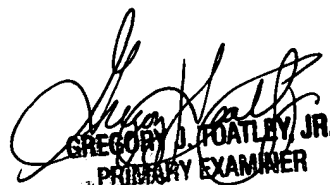
3. As it was stated above, the Examiner has concluded that he is lacking an understanding of the claims language and was precluded from further art examination of the application. Therefore, the Arguments presented by an Applicant are moot until further clarification of the claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zeev Kitov whose telephone number is (703) 305-0759. The examiner can normally be reached on 8:00 – 4:30. If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone numbers for organization where this application or proceedings is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Z.K.  
05/05/2003

  
GREGORY J. ROATLEY, JR.  
PRIMARY EXAMINER